



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

09/805,934

03/15/2001

Satoshi Nakamura

040894-5643

3631

9629

7590

10/21/2002

MORGAN LEWIS & BOCKIUS LLP
1111 PENNSYLVANIA AVENUE NW
WASHINGTON, DC 20004

EXAMINER

DINH, TUAN T

ART UNIT

PAPER NUMBER

2827

DATE MAILED: 10/21/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/805,934

Applicant(s)

NAKAMURA ET AL.

Examiner

Tuan T Dinh

Art Unit

2827

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 August 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-5 is/are rejected.
- 7) ☒ Claim(s) 2 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 05 August 2002 is: a) ☒ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 8/5/02 have been fully considered but they are not persuasive.

Applicant argues:

(a) PA and Goenka do not teach "said metallic sheet has, at its one end, an extending portion being externally exposed and being connected to a grounding terminal on the circuit board.

(b) PA and Goenka do not teach "solder means for soldering an extending portion externally exposed and formed at the end of said metallic sheet to a grounding terminal of said circuit board.

Examiner disagrees.

Response to argument (a), PA discloses a grounding terminal (32, page 1, line 19) on a circuit board (31, page 1, line 20), Goenka shows a protection sheet (16) having a metallic sheet (16m) has, at its one end, an extending portion (outer part (18, column 3, line 36) of the protection sheet (16) being externally exposed (see figures 4, 6-7) and connected to a ground portion (gasket 40) on a circuit board (12), and also, applicant does not claim the extending of the metallic sheet (the metallic sheet is sandwich by the insulation films) not includes a part of the insulation sheet to connect to a ground portion of the circuit board. This teaching of Goenka to provide for PA in combination that proves the argument of applicant is not persuasive.

Response to argument (b), in combination of PA in view of Goenka, Goenka shows a solder means (column 1, lines 21-25, column 3, lines 13-20) for soldering the extending portion (18) of the protection sheet (16) to a ground portion of the circuit board.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 3-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Prior Art (figure 12, submitted by Applicant) in view of Goenka et al. (U. S. Paten 5,968,386).

As to claims 1 and 5, PA shows a sheet on a printed circuit board (31-figures 11-12) having electrical components ground terminals (32).

PA does show a noise protection sheet having a metallic sheet and sandwich by insulating films.

Goenka discloses a noise protection sheet (16-figure 1, column 2, lines 35-36) as shown in figures 1-7 comprising:

a metallic sheet (16m, column 3, lines 13-14), and

insulating films (16p, column 3, line 13) which sandwich the metallic sheet in-between thereof, wherein

said metallic sheet (16m) has, at its one end, an extending portion being externally exposed.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the noise protection sheet as taught by Goenka to employ the EMI circuit board of PA in order to reduce heat dissipate and RFI. Also, the noise protection sheet would be provided the circuit board improved protection against harsh environment.

As to claim 3, PA discloses all of the limitations of the claimed invention, except for said extending portion having a through hole. Goenka discloses the noise protection sheet as shown in figure 7 wherein said extending portion has a through-hole (screw 42-figure 7, column 3, lines 54-60).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to use a through hole on the extending portion of the sheet as taught by Goenka to modify the EMI circuit board of PA in order to secure the gasket on board.

As to claim 4, PA and Goenka disclose the noise protection sheet on the circuit board as shown in figures 12 (PA) and 7 (Goenka) wherein said extending portion is formed in a bent shape so as to fit a shape of at least one of said electronic components when the noise protection sheet is stuck on said electronic components.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to use a bent shape of the extending portion as taught by Goenka

to employ the EMI circuit board of PA in order to protect components without short circuit when assembly the sheet on board.

Allowable Subject Matter

4. Claim 2 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tuan T Dinh whose telephone number is 703-306-5856. The examiner can normally be reached on M-F.


Art Unit: 2827

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David L. Talbott can be reached on 703-305-9883. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-1341 for regular communications and 703-305-1341 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0956.

TD

October 16, 2002.


ALBERT W. PALADINI
PRIMARY EXAMINER